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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,119	04/02/1999	ITALO GOFFI	ITALO-ET-AL-	4550

7590 11/19/2004

COLLARD & ROE
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EXAMINER

LORENZO, JERRY A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/286,119

Applicant(s)

GOFFI ET AL.

Examiner

Jerry A. Lorengo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 0204 and 11 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-64, 66, 67 and 70-74 is/are rejected.
- 7) ☒ Claim(s) 65, 68 and 69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20041117</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

(1)

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 71 and 72 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a "gas-tight thermoformable transfer support", does not reasonably provide enablement for a "substantially gas-tight thermoformable transfer support.". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The instant specification is enabling for a "transfer support"; a "gas-tight thermoformable transfer support"; and a "transfer support realized from polyvinyl alcohol . . . which is gas-tight and thermoformable." The instant specification, however, provides no support for a "substantially gas-tight thermoformable transfer support" as disclosed in applicant claims 71 and 72.

(2)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 71 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claims 71 and 72 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The use of the term "substantially" in describing the gas-tight thermoformable transfer support renders the claims indefinite because it

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is not possible, given the disclosure as originally filed” to determine to what degree the transfer support is gas-tight and thermoformable.

(3)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 62, 63, 64, 70, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,893,964 to Claveau (hereinafter “Claveau ’964”) in view of U.S. Patent No. 5,308,426 to Claveau (hereinafter “Claveau ’426”).

Regarding applicant claims 62 and 70, 73 and 74, Claveau ’964 discloses a process and apparatus for treating an article (artefact) having the steps of (Figures 8-10; column 3, lines 27-64:

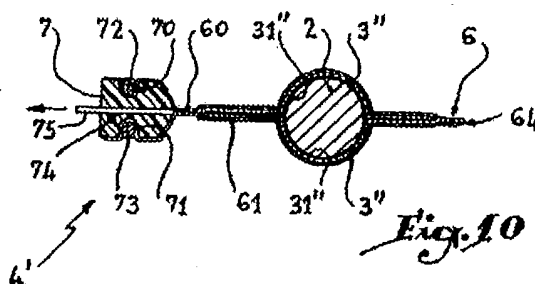
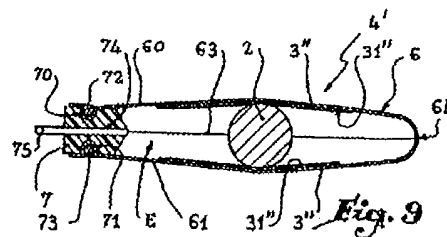
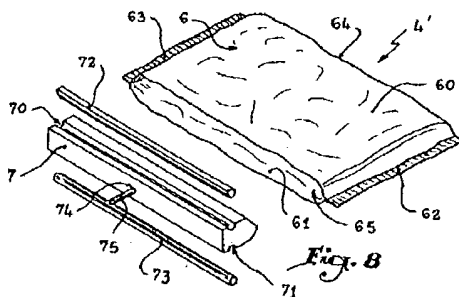
(1) Forming an envelope 4' (enclosing/forming means) from a transfer support 6 (which is adapted to receive an article 2 therein) by folding the transfer support 6 in such a manner that it forms two parallel sections 60, 61 with side edges perpendicular to the fold (which are sealed to form sealed edges 62,63) and an open end 65 defined by the edge portions of the transfer support 6 parallel to the fold;

(2) Placing inkers 3'' carrying a transferable decoration (pattern) 31'' on their surfaces onto the two parallel sections 60,61 of the transfer support 6;

(3) Placing the article 2 within the envelope 4' such that the inkers 3'' are disposed between the article 2 and the two parallel sections 60,61 of the transfer support 6 forming envelope 4';

(4) Evacuating (sucking) air from the open end 65 of the envelope 4' with a sucking means, such as a vacuum pump, to cause the transfer support 6 and interposed inkers 3'' to come into intimate contact (adhere) to the sides of the article 2; and

(5) Transferring a pattern (decoration) 31'' from inkers 3'' onto the article 2 by heating both the envelope 4' and the article 2 therein with a heating means, such as a furnace, under the effects of pressure provided by the evacuation of the flexible envelope 4' (which also functions as the pressing means). The method of Claveau '964 is illustrated below:



Although Claveau '964 discloses that pressure is applied to the decoration (pattern) 33" by the effect of the transfer support envelope 4" under evacuated conditions, they do not specifically disclose, as per applicant claims 62, 70, 73 and 74, that the pressure is applied to the pattern directly by the transfer support 6 from which the envelope 4' (enclosing and pressing means) is formed, i.e., the transferable pattern is carried directly upon the transfer support

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to form the envelope 4' (enclosing and pressing means) of Claveau '964 with a transfer support having the transferable decoration (pattern) carried directly thereon without the use of the inkers 3" motivated by the fact that Claveau '426, also drawn to methods for the formation of transferable decorative patterns onto three-dimensional articles through the use of an evacuated envelope, discloses that the drawbacks of using such inkers 3" (such as failure to deform along its principal axes leading to creases and offsetting in the transferred decoration) can be avoided by utilizing a transfer support of extensible material having the decoration (pattern) carried directly on its surface such that the object, of any shape, to be decorated is enveloped in the extensible transfer support so that the ink-coated face of the transfer support is directly in contact with the surfaces of the object to be decorated (column 1, line 5 to column 2, line 25).

Regarding applicant claim 63, Claveau '964 discloses that the envelope 4" may be alternatively formed from a two transfer support sheets 8a,8b with the first 8a placed above the article 2 and the second sheet 8b placed below the article (Figures 12 and 13).

Regarding applicant claim 64, although neither Claveau '964 nor Claveau '426 specifically disclose that the transfer support is removed after handling and/or installation of the article, the skilled artisan would have appreciated the advantages of leaving the transfer film in place until utilization by the end use motivated by the fact that the transfer support would protect the decorated surface from marring by scuffs, scrapes and bumps during the time period between application, storage and final use. Furthermore, the skilled artisan would have appreciated the utility of leaving the transfer support in place until final use motivated by the fact that it is well known in the art that decorative bezels are commonly provided with a removable plastic protective film that remains over the bezel until removed by the end user.

(4)

Claims 66 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (3), above, in further view of U.S. Patent No. 6,136,126 to Fenzi.

Although the references as combined in section (3), above, disclose the overall method and apparatus of the instant invention, they do not specifically disclose, as per applicant claims 58 and 59, the times and temperatures utilized in the heating steps.

Nonetheless, the claimed times and temperatures would have been obvious to one of ordinary skill in the art at the time of invention motivated by the fact that Fenzi, also drawn to methods and apparatus of heat and vacuum transfer decorating by way of an enveloping means, discloses that the temperature and time parameters utilized during the heating step may be up to 280°C and from 30 seconds to 30 minutes, respectively (column 2, lines 57-51).

(5)

Allowable Subject Matter

Claims 65, 68 and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 71 and 72 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: Claveau '426, as combined in section (1), above, discloses that the transfer support comprises an extensible material, such as air-permeable fabric, on which is disposed the transferable decoration. Although WO 99/04982 to Claveau, also drawn to methods of heat and vacuum transfer decorating by way of an enveloping means, disclose that it is known to utilize a transfer support, having the transferable decorative pattern 12 carried thereon, consisting of a extensible, air-permeable transfer support 10, having a coating 11 of PVA disposed thereon, neither they nor any of the prior art of record specifically disclose, as per applicant claims 68-71 that the transfer support is made from a gas-tight thermoformable material such as polyvinyl alcohol (PVA). The prior art is also silent as to the intermediate step, as set forth in applicant claim 65, of submitting

the artifact, after sucking, to a heating action at a temperature at which the transfer support is thermoformed.

(6)

Response to Amendments and Arguments

The amendments and arguments filed on August 24, 2004 and the supplemental amendments and arguments filed on November 11, 2004 are acknowledged.¹ In response, claims 62, 63, 64, 66, 67, 70, 73 and 74 have been rejected as set forth in sections (3) and (4), above. Claims 71 and 72 have been rejected under both the 1st and 2nd paragraphs of 35 U.S.C. § 112, as set forth in paragraphs (1) and (2). Claims 65, 68, 69, 71 and 72 have been objected to as containing allowable subject matter as set forth in section (5), above.

Applicant's arguments have been fully considered but they are not persuasive. The Applicant's main argument is that although the secondary reference, U.S. Patent No. 5,308,426 to Claveau (hereinafter "Claveau '426"), does disclose a transfer support comprising an envelope having the transferable decoration carried on its interior surface, Claveau '426 discloses that his transfer support is to be utilized with an auxiliary apparatus which applies a vacuum to the transfer envelope by exterior elastic membranes. While this may in fact be correct, the Examiner respectfully submits that the Claveau '426 reference was utilized to show that:

... it would have been obvious to one of ordinary skill in the art at the time of invention to form the envelope 4' (enclosing and pressing means) of Claveau '964 with a transfer support having the transferable decoration (pattern) carried directly thereon without the use of the inkers 3" motivated by the fact that Claveau '426 . . . discloses that the drawbacks of using such inkers 3" (such as failure to deform along its principal axes leading to creases and offsetting in the transferred decoration) can be avoided by utilizing a transfer support of extensible material having the decoration (pattern) carried directly on its surface
...

Thus, the Examiner respectfully submits that the auxiliary apparatus of Claveau '426 is not fatal to the suggestion to substitute the transfer support of Claveau '426 for the transfer

¹ The subject matter of the amended claims and arguments were discussed during a series of brief telephonic interviews conducted between the Examiner and Mr. William Collard on 10/28/2004; 11/01/2004 and 11/02/2004. These conversations are summarized in the Interview Summary attached hereto.

support and inker sheets of Calveau '964. The Applicant also argues that the closed transition language, "consisting of" of Applicant claims 62 and 70 would exclude the use of the transfer support of Claveau '426 because of the alleged need for an auxiliary apparatus. This is not persuasive. The Examiner respectfully submits that claims 62 and 70, while utilizing closed transition phrasing, also only describe the decoration transfer means as a "transfer support." Thus, the transfer envelope of Claveau '426, being a "transfer support," is not excluded. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus attacking Claveau '426 based upon a vague recitation by that reference of the need for an auxiliary apparatus is insufficient to overcome the combination of Calveau '964 in view of Claveau '426.

(7)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

(8)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This prior art includes that listed as reference N on the enclosed Form PTO-892.

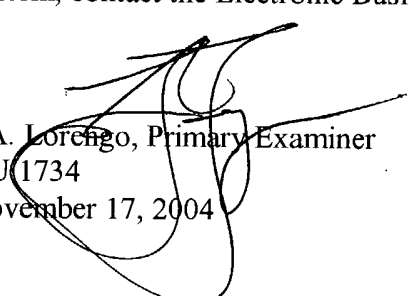
(9)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J.A. Lorengo, Primary Examiner
AU 1734
November 17, 2004